IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	:	Girouard, et al.
Appl. No.	:	09/827,772
Filed	:	April 6, 2001
For	:	SYSTEM AND METHOD FOR HOSTING OF VIDEO CONTENT OVER A NETWORK
Examiner	:	Bharat Barot
Group Art Unit	:	2155

CERTIFICATE OF MAILING

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October 20, 2006
(Date)

Raimond J. Salenieks, Reg. No. 37,924

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPEAL BRIEF

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief relates to an appeal to the Board of Patent Appeals and Interferences of the final rejection set forth in a final Office Action mailed February 22, 2006, and an Advisory Action mailed on June 8, 2006, in the above-captioned application.

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I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of this application, Virage, Inc.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals or interferences.

III. STATUS OF THE CLAIMS

The application was originally filed with Claims 1-23. In response to a first Office Action mailed on September 30, 2004, Claims 5, 11, 12, 17, and 21 were amended. Claims 1, 11, 17 and 23 were amended and Claims 24-32 were added in an amendment filed on June 10, 2005.

In a second non-final Office Action mailed on June 20, 2005, the Examiner did not enter the claim amendments submitted on June 10, and rejected Claims 11-23 and indicated that Claims 1-10 were allowable. In response to the second non-final Office Action, on November 21, 2005, Appellant filed a response in which Claims 1, 11, 17, and 23 were amended, and Claims 24-32 were added.

In a final Office Action mailed on February 22, 2006, Claims 1-16 and 23-28 were indicated as allowable, while Claims 17-22 and 29-32 were rejected.

In response to the final Office Action, Claims 17 and 23 were amended. An Advisory Action was mailed on June 8, 2006, in which the Examiner entered the amendments submitted in response to the final Office Action, and indicated that the amendments has overcome the rejections of the claims based on 35 U.S.C. § 112, but had not overcome the rejections based on 35 U.S.C. § 102.

Appellant thus appeals the rejections of Claims 17-22 and 29-32 under 35 U.S.C. § 102.

IV. STATUS OF AMENDMENTS

All offered amendments have been entered. Thus, Claims 1-32 appear before the Board as they were finally rejected (or allowed in the case of Claims 1-16 and 23-28), and the claims are attached hereto as Appendix A.

V. SUMMARY OF CLAIMED SUBJECT MATTER

As described in the application as filed, embodiments of the invention include methods and systems for using dynamically generated HTML and branded, embedded video player windows, to deliver content to end users in a seamless fashion, such that the end user does not perceive that they have ever 'left' the content owner's website. *See Application at p 3, l. 16-20.*

Claim 17 recites a method for hosting of video content over a network. The method comprises providing video content from a video content source for video processing. *See Application at p. 4, l. 12; p. 17, l. 26 through p. 18, l. 4; Figures 3, 4, 5.* The method further includes encoding the video content, wherein the encoded content is provided to a network. *See Application at p. 4, ll. 13-14; p. 18, ll. 5-18; Figures 3, 4, 5.* The video content is also indexed to generate a video index. *Id.* The method further includes providing video elements from a video application for incorporation in a content owner network site. *See Application, page 18, l. 19 through p. 19, l. 5; see also page 16, l. 21-24 and Figures 3, 4, 5.* The encoded video is delivered to a user via the network based on user selection. *See Application, page 19, l. 6 through p. 20, l. 14; Figures 2, 3, 6.* The method further provides that the video content is delivered from a remote location to the location where the video content is encoded and indexed. *See Application, page 14, l. 21 through p. 16, l. 4; Figures 2, 3.* The content owner network site is also remote from the location where the video content is encoded and indexed. *Id.*

Claim 20 recites a method according to Claim 17, wherein the content owner network site includes a content owner website. *See Application, page 15, lines 24-30, Figures 2, 3.*

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

This Appeal turns on the following issue:

(1) Claims 17-22 and 29-32 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Pat. No. 6,567,980 to Jain, et al.

VII. APPELLANT'S ARGUMENT

A. Claims 17-22 and 29-32 are Patentable over Jain

1. The Examiner's Grounds for Rejection

Regarding Claim 17, the Examiner stated that "Jain et al teach a method for hosting of video content over a network (figure 1; column 2 lines 5-39; and column 3 line 50 to column 4

line 9)" *Final Office Action at page, 3, para. 8.* The Examiner further stated that Jain discloses "providing video content from a video content source for video processing [at] (figure 1; and column 3 lines 52-60)." *Id.* According to the Examiner, "indexing the video content to generate a video index" is shown in Jain at Figure 1, at column 4, lines 1-4, and at column 5, line 51 to column 6, line 25. *Id.* The Examiner further stated that Jain discloses "delivering the encoded video to a user via a network based on user selection (figure 1; and column 13 lines 4-11 and 21-28) and that "the video content is delivered from a remote location (source) to the location where the video content is encoded and indexed (system 100)."

The Examiner further argued that Jain discloses "a content owner network site (client computer/network mass storage device visible to the client computer)" and that the site "is also remote from the location where the video content is encoded and indexed (system 100) (figure 1; column 3 line 50 to column 4 line 9; and column 13 lines 4-11 and 21-28)." *Id.*

Regarding Claim 20, the Examiner stated that Jain teaches that the content owner network site includes a content owner website at Figure 1 and at column 4, lines 5-18 and at column 13, lines 4-11 and 21-28.

2. <u>The Legal Standard</u>

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Although the express, implicit, and inherent disclosures of a prior art reference may be relied upon in rejecting claims under section 102, the fact that a certain result or characteristic *may occur or be present in the prior art is not sufficient* to establish the inherency of that result or characteristic. MPEP 2112; *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Moreover, "the missing descriptive matter [must be] necessarily present in the thing described in the reference." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

3. Jain Fails to Teach Providing Video Elements from a Video Application for Incorporation into a Content Owner Network Site as Recited in Claim 17

Claim 17 recites in part:

> providing video elements from a video application for incorporation into a content owner network site; and
>
> ... wherein the content owner network site is also remote from the location where the video content is encoded and indexed.

The Examiner contends that the feature of "providing video elements from a video application for incorporation into a content owner network site" is taught in Jain at column 4, lines 5-18 and at column 5, lines 18-60. The Examiner further states that the Jain shows "the content owner network site is also remote from the location where the video content is encoded and indexed" by the system 100 and at column 3, line 50 through column 4, line 9, and further at column 13, lines 4-11 and 21-28.

Appellant respectfully submits that the cited passages in Jain do not teach or suggest providing "video elements from a video application" into a content owner network site that is "remote from the location where the video content is encoded and indexed" as provided in the claim.

As noted above, in order to anticipate a claim, every element and limitation of the claim must be found in a single prior art reference. The Examiner relies on the structure shown in Figure 1 as providing a teaching that the content owner network site (equated in the Examiners rejection alternatively to clients 150 – [see Final Office Action at p. 4, lines 6-7] and content server 140 [see Final Office Action, at p. 4, lines 1-2]).

However, to the extent that the Examiner equates the content owner network site to the "client computer/network mass storage device visible to the client computer," there is no explicit teaching that this device is a content owner network site. If the Examiner is relying upon an inherency argument, this reliance is misplaced. In relying on the inherent disclosure of a reference to support a finding of anticipation, the missing descriptive matter must be necessarily present in the thing described in the reference. *In re Robertson*, 169 F.3d at 745. Here, the storage devices visible to the client computer could be owned by any number of entities and not necessarily the content owner. For instance, the storage devices could be located at a content

encoding service provider's site. Thus, "the network mass storage device visible to the client computer" cannot be relied upon to establish the inherent presence of a content owner network site.

Moreover, to the extent that the Examiner equates the content server 140 to the content owner network site, there is no indication that the content server is placed remotely to the location of video encoding and indexing. In rejecting Claim 17, the Examiner stated that the "location where the video content is encoded and indexed" is the system 100. As is apparent from Figure 1 in Jain, the content server 140 (which is alleged to be the content owner network site) is part of system 100. Thus, it defies explanation how the content server 140 would necessarily be remote to something of which it is a part.

Moreover, even if the video cataloger 110 and the encoder process 120 are equated with the "location where the video content is encoded and indexed," there is no explicit teaching that these system components are remote from the content server 140. The Examiner appears to rely on Jain's indication that the encoder process 120 is connected to the content server 140 by a network channel 122. However, Jain never explicitly states that the network channel 122 links components that are located remotely from each other. As explained above, if the Examiner relies on the inherent disclosure of a reference, the missing descriptive matter must be necessarily present in the thing described in the reference. The network channel 122 could take many forms, including a local network configuration in which the encoder process and the content serving take place in the same location. Thus, without an explicit teaching that the encoder process 120 and the content server 140 are remotely located with respect to each other, Jain cannot be relied upon as an anticipatory reference for Claim 17.

As a result, Jain fails to teach each and every element recited in Claim 17. As a result, Appellant submits that Claim 17 is allowable over the art made of record for at least this reason.

4. <u>Jain Fails to Teach the Feature of Video Content Delivered from a Remote Location To the Location Where Video Content is Encoded and Indexed</u>

Claim 17 further recites:

> delivering the encoded video to a user via the network based on user selection;
>
> wherein the video content is delivered from a remote location to the location where the video content is encoded and indexed ....

In finally rejecting Claim 17, the Examiner stated that the feature of delivering encoded video to a user via a network based on user selection is shown at Figure 1 and in column 13, lines 4-11 and 21-28. The Examiner further stated that "the video content is delivered from a remote location (source) to the location where the video content is encoded and indexed (system 100)." From the Examiner's statements, it seems clear that the Examiner has interpreted "wherein the video content is delivered from a remote location to the location wherein the video content is encoded and indexed" as referring back to the step of "providing video content from a video content source." Such an interpretation is incorrect. This "wherein" clause refers to the previous feature of "delivering the encoded video to a user via the network." Thus, the video content that is delivered is already encoded video. The Examiner's rejection erroneously relies on a remote location of unencoded video (i.e., the source 102). The source 102 cannot be the location from which video content is "delivered to a user via the network" because the video content stored at the source 102 is not encoded. Thus, the only component shown in Jain that could possibly be equated with the "remote location" from which the video content is delivered is the content server 140. As discussed above, however, there is no explicit teaching in Jain that the content server 140 is located remotely to the video encoder 120 or the video cataloger 110, and in various configurations, these components could be part of a a local network configuration in which the encoder process, video cataloger, and the content server are the same location. As a result, Claim 17 is allowable over Jain for at least this additional reason.

5. Jain Fails to Teach a Content Owner Network Site Including a Content Owner Website as Recited in Claim 20

Claim 20 recites:

> The method as defined in Claim 17, wherein the content owner network site includes a content owner website.

Appellant submits that Jain fails to teach at least the recited feature of a content owner website, and in fact Jain explicitly states that no website is required. The Examiner cites column 13, lines 4-11 and 21-28 as disclosing this feature. However, at column 13, lines 14-18, Jain explicitly teaches that a website is unnecessary in this system (emphasis added):

> Some key features of the Video Cataloger HTML output are:
>
> a. The HTML files used to generate the display in the browser window 916 (FIG. 17) are completely stand-alone, internally linked

> HTML, such that **no Web server is required**. Exemplary HTML files are provided in the Appendix and are described in conjunction with FIG. 17 below.

Thus, Jain's teachings do not include the use of a website, but in fact teach precisely the opposite. Moreover, the passages cited by the Examiner in column 13 make clear that the files generated at locally stored and not served by a website. Accordingly, Claim 20 is allowable over Jain for at least this additional reason.

6. Claims 17-22 and 29-32 Are Thus Patentable

Thus, as Jain fails to teach each and every feature in Claims 17 and 20, Appellant respectfully submits that Claims 17 and 20 are in condition for allowance.

Because Claims 18-22 and 29-32 depend from Claim 17, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claim to which they refer. It is therefore submitted that these claims are in condition for allowance at least for the reasons expressed above, and for their other features.

B. Conclusion

In view of the foregoing arguments and the previous indications of allowability of Claims 1-16 and 23-28, Appellant respectfully submits that all pending Claims 1-32 are patentable over the prior art of record.

VIII. APPENDICES

Attached hereto as Appendix A is a copy of finally rejected Claims 1-32 in the present case. Also attached is Appendix B for inclusion of evidence and indicating no evidence is included, and Appendix C for inclusion of information regarding related proceedings and indicating no information regarding related proceedings is included.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 20, 2006

By: _____

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APPENDIX A: CLAIMS

(Claims as finally rejected)

1. (Previously presented) A system for hosting of video content over a network, comprising:

a content owner facility comprising a content owner network server;

a service facility receiving the video content from a content source, the service facility comprising:

a video encoding module configured to encode the video content;

a video logging module configured to generate an index of the video content;

a video application server module configured to receive the index of the video content; and

a service facility network server configured to receive the index of the video content and produce electronic templates for use by the content owner network server; and

a content distribution network configured to receive encoded video content from the video encoding module and provide encoded video content to a user based on user selection.

2. (Original) The system as defined in Claim 1, wherein the content owner network server comprises a content owner web server having a plurality of content owner electronic pages.

3. (Original) The system as defined in Claim 1, wherein the service facility further comprises a video index database including video index data.

4. (Original) The system as defined in Claim 3, wherein the video index database further includes video metadata.

5. (Previously presented) The system as defined in Claim 1, wherein the content owner facility includes a content owner website.

6. (Original) The system as defined in Claim 1, wherein the service facility network server includes a service facility web server.

7. (Original) The system as defined in Claim 6, wherein the service facility web server is configured to produce one or more search form web pages.

8. (Original) The system as defined in Claim 6, wherein the service facility web server is configured to produce search results information.

9. (Original) The system as defined in Claim 1, wherein the service facility further comprises an administration module configured to manage the service facility network server.

10. (Original) The system as defined in Claim 1, wherein the service facility further comprises a video editorial module configured to allow human-directed annotation of the video content.

11. (Previously presented) A system for delivering media content services over a network, comprising:

media content to which a content owner has rights;

a content owner facility comprising a content owner web site associated with a content owner network server;

a service facility receiving the media content from a media content source, the service facility comprising:

a video processing module configured to extract metadata from the media content and encode the media content; and

a hosted video application module configured to provide video elements for display on the content owner web site at the content owner facility; and

a content distribution network providing media content to a user from the service facility based on user selection.

12. (Previously presented) The system as defined in Claim 11, wherein the service facility further comprises a network server.

13. (Original) The system as defined in Claim 11, wherein the network is the Internet.

14. (Original) The system as defined in Claim 12, wherein the network server is a web server.

15. (Original) The system as defined in Claim 11, wherein the video elements include HTML instructions.

16. (Original) The system as defined in Claim 11, wherein the media content is encoded video content.

17. (Previously presented) A method for hosting of video content over a network, comprising:

providing video content from a video content source for video processing;

encoding the video content, wherein the encoded content is provided to a network;

indexing the video content to generate a video index;

providing video elements from a video application for incorporation in a content owner network site; and

delivering the encoded video to a user via the network based on user selection;

wherein the video content is delivered from a remote location to the location where the video content is encoded and indexed, and wherein the content owner network site is also remote from the location where the video content is encoded and indexed.

18. (Original) The method as defined in Claim 17, wherein the network comprises a content distribution network.

19. (Original) The method as defined in Claim 17, further comprising storing the video index in a database.

20. (Original) The method as defined in Claim 17, wherein the content owner network site includes a content owner website.

21. (Previously presented) The method as defined in Claim 17, wherein the video elements comprise HTML instructions.

22. (Original) The method as defined in Claim 17, further comprising providing search results information.

23. (Previously presented) The system as defined in Claim 1, wherein the service facility further comprises an administration module configured to manage the service facility network server.

24. (Previously presented) The system as defined in Claim 1, wherein receiving the video content from a content source comprises receiving one or more computer files electronically.

25. (Previously presented) The system as defined in Claim 1, wherein receiving the video content from a content source comprises receiving one or more physical copies of the content.

26. (Previously presented) The system as defined in Claim 25, wherein at least one of the physical copies is received on an optical disk or video tape.

27. (Previously presented) The system as defined in Claim 1, wherein receiving the video content from a content source comprises receiving a broadcast signal.

28. (Previously presented) The system as defined in Claim 1, wherein the content source comprises the content owner facility.

29. (Previously presented) The method as defined in Claim 17, wherein providing video content from a video content source comprises providing one or more computer files electronically.

30. (Previously presented) The method as defined in Claim 17, wherein providing video content from a video content source comprises providing one or more physical copies of the content.

31. (Previously presented) The method as defined in Claim 17, wherein providing video content from a video content source comprises providing a broadcast signal.

32. (Previously presented) The method as defined in Claim 17, wherein the video content source comprises a content owner facility.

APPENDIX B: EVIDENCE

None

APPENDIX C: RELATED PROCEEDINGS

None

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